

**REMARKS**

**I. Status of Claims**

Without prejudice or disclaimer, Applicants have amended independent claim 1 to incorporate subject matter encompassed by the specification and now-cancelled claims 10 and 11; have amended claims 12 and 16 to perfect antecedent basis. Additional support for the amendment to claim 1 may be found in Applicants' specification as-filed at, for example, page 6 at paragraphs [020] and [021], page 7 at paragraph [025], page 8 at paragraphs [032] - [034], page 10 at paragraph [041], and the Examples. Applicants have cancelled claims 10 and 11 without prejudice or disclaimer of their subject matter. Thus, claims 1, 2, 5, 8, 9, 12, 16, 18, 19, 21-24, 26, 36, 40, 45, 71, 73, 77, 79, 82 and 83 are currently pending, with claims 1, 2, 5, 8, 9, 12, 18, 19, 21-24, 26, 36, 40, and 45 under current examination. Claims 71, 73, 77, 79, 82, and 83 were withdrawn from consideration in response to the Office Action (Restriction/Election Requirement) dated October 10, 2007. The Examiner indicates that claim 16 is also being withdrawn from consideration further to Applicants' response to the Office Action (Restriction/Election Requirement) dated October 10, 2007. See March 21, 2008, Office Action ("Office Action") at 2.

Applicants respectfully remind the Examiner, if the elected species is found allowable, of her duty to continue to examine the full scope of the elected subject matter to the extent necessary to determine the patentability thereof, *i.e.*, extending the search to a "reasonable" number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

II. Rejection Under 35 U.S.C. § 103(a)

The Examiner rejects claims 1, 2, 5, 8-12, 18, 19, 21-24, 26, 36, 40, and 45 under 35 U.S.C. § 103(a) as allegedly "being unpatentable over the combination of" U.S. Patent No. 3,911,105, to Papantonio et al. ("the '105 patent") and U.S. Patent No. 5,866,111, to Felardos et al. ("the '111 patent"). Office Action at 3. As noted claims 10 and 11 have been cancelled without prejudice or disclaimer of their subject matter.

The Examiner asserts that the '105 patent "teaches cosmetic make up compositions using polystearyl acrylate. This compound is the species of formula II." Office Action at 4. The Examiner cites the examples and claims 1-12 and "especially claim 5" of the '105 patent to support this assertion. *Id.* The Examiner admits that the '105 patent "does not teach the film forming polymer sulfoester." *Id.* Thus, the Examiner cites the '111 patent to cure the deficiencies of the '105 patent, asserting that the '111 patent "teaches the [elected] claimed sulfoester as the film forming 'polymer.' *Id.*

Applicants disagree with the Examiner's assertions and respectfully traverse the Examiner's § 103(a) rejection for at least the reason that the Examiner has failed to make a *prima facie* showing of obviousness. Several basic factual inquires must be made in order to determine whether the claims of a patent application are obvious under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;

- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 USPQ 467; *see also KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727,1734 (2007).

The Supreme Court, in the *KSR* decision, recognized that a showing of "teaching, suggestion, or motivation" could provide helpful insight in determining whether the claimed subject matter is obvious under Section 103(a). *KSR*, 127 S. Ct. at 1741. In addition, the Supreme Court mandates that "[t]o facilitate review, this analysis [of whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue] should be made explicit." *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

Indeed, to establish a *prima facie* case of obviousness, the Examiner must:

make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

M.P.E.P. § 2142. "The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious."

M.P.E.P. § 2143.

The '105 patent discloses "[a] fatty composition for use in producing cosmetic composition[s] comprising a mixture of at least one cosmetic fatty body and at least one non-toxic polymer." '105 patent, Abstract. However, the '105 patent fails to disclose or suggest Applicants' claimed invention, at least because the '105 patent does not disclose the use of polystearyl acrylate, contrary to the Examiner's assertions. Example 8 of the '105 patent contains polystearyl methacrylate, and Example 9 contains "polystearyl methacrylate crosslinked with 0.02% ethylene glycol dimethacrylate." Claim 5 recites polystearyl acrylate, but there is no reference or citation of polystearyl acrylate in the specification of the '105 patent, or in any of claims 1-4 and 6-12. Moreover, polystearyl methacrylate is not disclosed in any of the claims of the '105 patent. Thus, it appears that claim 5 of the '105 patent should disclose polystearyl methacrylate instead of polystearyl acrylate.

In addition, the '105 patent fails to disclose or suggest, any desired thermal profile or melting peak, and certainly not "[a] cosmetic composition comprising ... at least one first compound which gives the cosmetic composition a thermal profile wherein the melting peak has a mid-height width Lf less than or equal to 10°C, wherein the at least one first compound has a thermal profile wherein the melting peak has a mid-height width Lf less than or equal to 10°C," as recited in amended independent claim 1.

Further, the '105 patent discloses the use of homopolymers, namely a homopolymer having repeating units of the formula (I) and a homopolymer having repeating units of the formula (II). See '105 patent, Abstract. The '105 patent thus does not disclose or suggest the use of the elected semi-crystalline polymers, which are copolymers, and certainly does not disclose or suggest use of the claimed "at least first one compound ... chosen from semi-crystalline polymers having a melting point ranging from 35°C to 65°C," as recited in amended independent claim 1.

As Applicants set forth in the specification, "the term 'semi-crystalline polymer' means polymers comprising at least one crystallizable portion, chosen from crystallizable pendent chains and crystallizable blocks, in the skeleton, as well as an amorphous portion in the skeleton ... [wherein] [t]he at least one crystallizable block is then of a different chemical nature from the at least one amorphous block."

Specification at paragraph [0043], emphasis added.

Thus the homopolymers, and moreover, the fatty compositions disclosed by the '105 patent, cannot disclose or suggest Applicants' invention, as recited in amended independent claim 1.

For at least these reasons, '105 patent fails to disclose or suggest Applicants' claimed invention, as recited in amended independent claim 1. The Examiner cites the '111 patent in an attempt to overcome the deficiencies of the '105 patent. The Examiner asserts that the '111 patent "teaches claimed sulfoester as the film forming polymer and using this film former in cosmetic compositions." Office Action at 4. Nevertheless, without acceding to the Examiner's allegations, Applicants submit that the

'111 patent does not cure all of the deficiencies of the '105 patent discussed above with respect to amended independent claim 1. Further, neither the '105 patent nor the '111 patent teach or suggest a composition wherein "the at least one amorphous film-forming polymer is present in an amount greater than or equal to the amount of the at least one first compound." See claim 1.

Moreover, neither reference separately or combined provide motivation to arrive at a composition as presently claimed. Therefore, the teachings of the '105 and '111 patents, separately, or even if combined as the Examiner suggested, do not render obvious Applicants' invention, as recited in amended independent claim 1.

For at least these reasons, the Examiner has not established a *prima facie* case of obviousness with respect to amended independent claim 1 in view of the '105 and '111 patents, separately or in combination. Independent claim 40, while differing in scope, recites similar limitations as claim 1 and is also allowable over the '105 and '111 patents. Claims 2, 5, 8, 9, 12, 18, 19, 21-24, 26, 36, and 45 are also allowable over the '105 and '111 patents, at least due to their respective dependence from base claim 1 or 40. Applicants therefore respectfully request withdrawal of the rejection of claims 1, 2, 5, 8, 9, 12, 18, 19, 21-24, 26, 36, 40, and 45.

III. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the examination of this application, and the timely allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, she is respectfully urged to contact Applicants' undersigned counsel at 202-408-4368.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By:   
Deborah M. Herzfeld  
Reg. No. 52,211

Dated: May 29, 2008